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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,426	12/22/2000	Hiroshi Matsuda	250-827	8033

7590

05/28/2003

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

12

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,426

Applicant(s)

MATSUDA, HIROSHI

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 6-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11-15, 18-22 and 25 is/are allowed.
- 6) ☐ Claim(s) 6-8 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except those described below are overcome by applicant's amendment filed 5/14/03.

In light of the new grounds of rejection as set forth in paragraphs 3 and 5 below with respect to JP 06049401, the finality of the previous office action has been withdrawn, and thus, the following action is non-final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 26 and 29-30 rejected under 35 U.S.C. 102(b) as being anticipated by JP 06049401.

JP 06049401 discloses a stencil printing emulsion ink comprising carboxyvinyl polymers that are water-soluble polymers such as acrylic acid resin or sodium polyacrylate. It is disclosed that the ink comprises 50-90% water phase and 10-50% oil phase (abstract, claim 1, paragraph 7, paragraph 14). The table on page 14 of the translation discloses that the ink contains 0.05-1.5% water-soluble polymer (last row of table).

In light of the above, it is clear that JP 06049401 anticipates the present claims.

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Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06049401 in view of Asada (U.S. 6,165,258).

The disclosure with respect to JP 06049401 set forth in paragraph 3 above is incorporated here by reference.

The difference between JP 06049401 and the present claimed invention is the requirement in the claims of borax.

Asada, which is drawn to stencil printing emulsion ink, disclose the use of 0.1-2% sodium borate, i.e. borax, as an emulsion stabilizer (col.6, lines 31, 37, and 40-43).

In light of the motivation for using borax disclosed by Asada as described above, it therefore would have been obvious to one of ordinary skill in the art to use borax in the ink of either between JP 06049401 in order to improve the stability of the ink, and thereby arrive at the claimed invention.

6. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06049401 in view of Asada (U.S. 6,165,258).

The rejection is adequately set forth in paragraph 8 of the office action mailed 9/25/02. Paper No. 8, and is incorporated here by reference.

Response to Arguments

7. Applicant's arguments filed 5/14/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that the ink of JP 06049401 employs higher fatty acid esters, such as sorbitan higher fatty acid ester, which form a liquid crystal structure between the oil phase and the water phase of the ink and thus, the ink of JP 06049401 is outside the scope of the present claims which require that the ink is free from such surfactants.

However, while present claims 6 and 26 each require that the ink is free from emulsifier which forms liquid crystal structure between oil phase and water phase, there is no evidence to support applicant's position that the higher fatty acid esters such as sorbitan higher fatty acid ester disclosed by JP 06049401 would form such liquid crystal structure between oil phase and water phase. That is, while the present specification defines emulsifiers that form liquid crystal structure between oil phase and water phase as polyglycerol fatty ester (page 2, line 15-page 3, line 3), there is no disclosure that the emulsifiers disclosed by JP 06049401, such as sorbitan higher fatty acid ester, would form such liquid crystal structure between the oil phase and the water phase of the ink. While page 5 of the amendment filed 5/14/03 states that the higher fatty acid esters of JP 06049401 would form such liquid crystal structure, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding JP 06049401 must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit

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form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

It is agreed that Asada discloses the use of emulsifier that forms liquid crystal structure between oil phase and water phase, namely, fatty acid esters of polyglycerin. It is noted, however, that Asada is no longer used as a primary reference against the present claims but only as a secondary or teaching reference in combination with JP 06049401 to teach the use of borax in stencil printing inks.

Allowable Subject Matter

8. Claims 11-15, 18-22, and 25 are allowable over the closest prior art JP 06049401 and Asada (U.S. 6,165,258) for the following reasons.

JP 06049401 discloses stencil printing emulsion ink comprising carboxyvinyl polymers that are water-soluble polymers such as acrylic acid resin or sodium polyacrylate wherein the ink comprises 50-90% water phase and 10-50% oil phase. However, there is no disclosure or suggestion of alkyl-modified carboxyvinyl polymer as required in present claims 11-15, 18-22, and 25.

Asada discloses a stencil printing water-in-oil emulsion ink comprising polymer including alkyl-modified carboxyvinyl polymer either alone or in combination with carboxyvinyl polymer and sodium borate, i.e. borax wherein the ink comprises 10-90% water phase and 10-90% oil phase. However, Asada discloses the use of fatty acid ester of polyglycerin, which, as set forth on page 2, line 15-page 3, line 3 of the present specification, is an emulsifier that forms liquid crystal structure between the oil phase and water phase of the ink. Thus, the disclosure of


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Asada is in direct contrast to the present claims, which require that the ink is free of such emulsifiers that form liquid crystal structure between the oil phase and water phase of the ink.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie E. Shosho
Examiner
Art Unit 1714

CS
May 28, 2003